



1 of 3

PATENT  
Customer No. 22,852  
Attorney Docket No. 05725.0490-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

#17

AKD

3-12-03

In re National Stage of International Application No. PCT/FR99/00609 of:  
Nadia TERREN et al.  
Application No.: 09/423,974  
International Filing Date: November 17, 1999  
35 U.S.C. §371 date: January 5, 2000  
For: USE OF A SILICONE SURFACTANT  
OF ALKYL-DIMETHICONE  
COPOLYOL TYPE FOR PREPARING  
SOLID WATER-IN-OIL COSMETIC  
EMULSIONS AND RESULTING  
SOLID WATER-IN-OIL EMULSIONS

Commissioner for Patents and Trademarks  
Washington, DC 20231

Sir:

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APPEAL BRIEF UNDER 37 C.F.R. § 1.192

In support of the Notice of Appeal filed October 4, 2002, and pursuant to 37 C.F.R. § 1.192, Appellants present in triplicate this brief and enclose herewith a check for the fee of \$320.00 required under 37 C.F.R. § 1.17(c). The period for response has been extended three months to March 4, 2003, by the accompanying petition and fee.

This Appeal is filed in response to the final rejection dated May 7, 2002, of claims 75-80, 82-93, and 96-107, which are set forth in the attached Appendix. A response to the Final Office Action was timely filed on August 7, 2002. An Advisory Action was

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issued on September 10, 2002. A Notice of Appeal was filed on October 4, 2002. If any additional fees are required or if the enclosed payment is insufficient, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

**I. Real Party In Interest**

L'Oréal S.A. is the assignee of record.

**II. Related Appeals and Interferences**

Appellants' undersigned legal representative knows of no other appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. Status Of Claims**

The Advisory Action lists claims 75-80, 82-94, and 96-107 as pending. Claim 94, however, was cancelled in the Amendment filed on August 7, 2002. Claim 108 is still pending but is withdrawn as relating to non-elected subject matter. See Final Office Action at p. 2.

Thus, it is believed that claims 75-80, 82-93, and 96-107 are at issue in this appeal. No claims have been allowed. Claims 75-80, 82-93, and 96-107 have been finally rejected under 35 U.S.C. § 103(a), and claim 107 has been finally rejected under 35 U.S.C. § 112, second paragraph.

**IV. Status Of Amendments**

All amendments have been entered, and no amendments under 37 C.F.R. § 1.116 have been filed.

**V. Summary Of Invention**

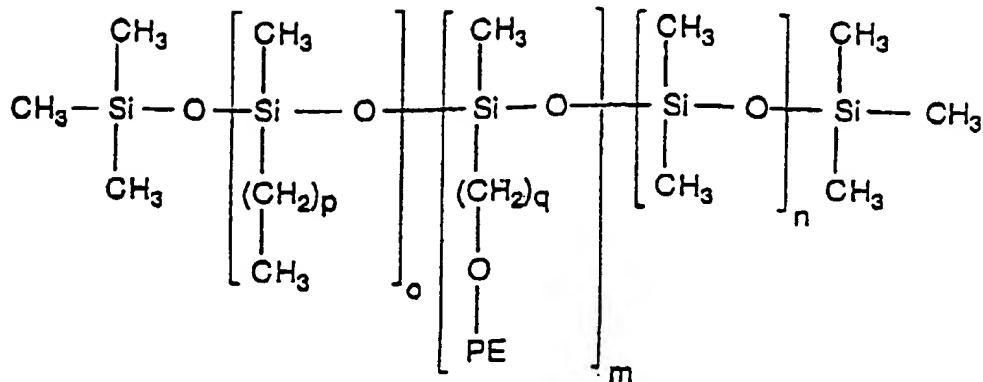
The present invention relates to a solid cosmetic water-in-oil emulsion comprising an alkyldimethicone copolyol silicone surfactant.

Solid emulsion foundations generally comprise fatty substances, such as waxes and oils. Specification at p. 1, line 25 to p. 2, line 1. When these compositions are applied to the skin, however, they exhibit the disadvantage of transferring to or at least being partly deposited on certain other substrates with which they may be brought into contact, such as clothing or skin. *Id.* at p. 2, lines 3-8. As a result, these prior art foundation compositions suffer from a "mediocre persistence" on the skin, requiring regular reapplication. *Id.* at 8-11. Moreover, these compositions suffer from poor dispersion of the pigments therein, resulting in an emulsion that is not homogeneous. *Id.* at 12-14. Other prior art water-in-oil emulsion cosmetic compositions have also exhibited nonhomogeneity, e.g., solid water-in-oil emulsions comprising silicone oils and solid waxes. The emulsifiers used in such compositions can be organopolysiloxanes modified by polyoxyalkylenes. *Id.* at 15-26.

The present invention relates to the surprising and unexpected discovery that by using a specific silicone surfactant of the alkyldimethicone copolyol type in combination with at least one oil and at least one wax, it is possible to obtain a solid water-in-oil emulsion that exhibits the desired characteristics discussed below and that also exhibits the advantage of not transferring. *Id.* at p. 3, lines 1-14. The silicone surfactant has the following formula:

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with specifically defined variables. *Id.* at p. 5, lines 1-13.

In the solid emulsions of the invention, the aqueous phase emulsified by the silicone surfactant is in a fatty phase comprising at least one oil and at least one wax. *Id.* at p. 3, lines 15-22. The inventive compositions, such as an emulsion, can result in a homogeneous water-in-oil emulsion with desired characteristics in which the pigments, dyes, and oils are well dispersed. In addition, the emulsion can be soft, can provide good slip and good hold, and can have good persistence on the skin. *Id.* at 1-6. Thus, the inventive compositions can provide the desired property of not transferring to other substances. *Id.* at 12-14. The emulsion can spread easily while maintaining homogeneity. *Id.* at p. 4, lines 7-11. It can have good moisturizing properties and cosmetic properties due to its softness and good slip. *Id.* Moreover, the emulsion, when applied to skin, does not migrate into the folds of the skin and/or wrinkles of the face. *Id.* at 14-16.

## VI. Issues

The issues presented for appeal are:

1. Whether claim 107 is indefinite under 35 U.S.C. § 112, second paragraph;

2. Whether claims 75-80, 82-86, 90-93, and 97-107 are unpatentable under 35 U.S.C. § 103(a) over EP 595 683 (Mellul)<sup>1</sup> in view of U.S. Patent No. 5,196,187 (Nicoll et al.);

3. Whether claims 75-80, 82-84, 90-93, and 96-107 are unpatentable under 35 U.S.C. § 103(a) over EP 595 683 (Mellul et al.) in view of U.S. Patent No. 5,650,139 (Nojima); and

4. Whether claims 75-80, 82-84, 87-93, and 97-107 are unpatentable under 35 U.S.C. § 103(a) over EP 595 683 (Mellul et al.) in view of U.S. Patent No. 4,536,405 (Nara et al.).

## VII. Grouping Of Claims

Each claim of this patent application is separately patentable, and upon issuance of a patent will be entitled to a separate presumption of validity under 35 U.S.C. § 282. For convenience in handling this Appeal, however, the claims will be grouped in one group. Thus, pursuant to 37 C.F.R. § 1.192(c)(7), in this Appeal, the rejected claims will stand or fall together.

## VIII. Argument

The independent claims on appeal (claims 75, 104, and 107) recite the common feature of (1) a solid cosmetic water-in-oil emulsion comprising an aqueous phase emulsified in a fatty phase comprising at least one oil and at least one wax, (2) the aqueous phase emulsified using an alkyl dimethicone copolyol corresponding to the indicated formula, and (3) the at least one wax in the fatty phase capable of conferring a

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<sup>1</sup> An English translation of Mellul is available as U.S. Patent No. 5,851,539. In this Brief, all Mellul

penetration force on the emulsion of greater than or equal to 50 grams. The independent claims also feature other limitations, which will be discussed in greater detail below.

**A. Rejection under 35 U.S.C. § 112: An “amount effective to provide transfer-resistant properties” is definite under 35 U.S.C. § 112, second paragraph**

The Office maintains the rejection of claim 107 under 35 U.S.C. § 112, second paragraph. According to the Office, neither the specification nor the claims clearly define the phrase, “transfer-resistant,” nor do they disclose an amount or range of effective amounts of the emulsion to provide this transfer resistance to the composition. Advisory Action; Final Office Action at p. 3. The Office believes that the specification provides insufficient guidance for one of ordinary skill in the art to determine the amount needed to provide transfer resistant properties. *Id.*

Appellants respectfully disagree. The standard of definiteness under 35 U.S.C. § 112, second paragraph, is a reasonable degree of clarity and precision. M.P.E.P. § 2173.02. “Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary

level of skill in the pertinent art at the time the invention was made.”

*Id.* Additionally, the use of relative terminology in a claim does not automatically render that claim indefinite, as the standard for indefiniteness is whether those of ordinary skill

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citations refer to the ‘539 patent.

in the art would be reasonably apprised of the scope of the invention. M.P.E.P § 2173.05(b).

More specifically, the case law well establishes that a term such as "amount effective" is definite if the specification provides general guidelines and examples sufficient to enable one of ordinary skill in the art to determine the metes and bounds of the claim. *In re Marosi*, 710 F.2d 799, 803 (Fed. Cir. 1983). The Office has the burden of showing indefiniteness by evidencing that a "determination of such amounts would be beyond the skill of the art ... [or] that it would involve undue experimentation to ascertain them." *In re Halleck*, 422 F.2d 911, 914 (C.C.P.A. 1970). The *Halleck* court further noted that a claim is not objectionable where the "exact point of novelty" resides in the claimed agents, and not the amount used. *Id.* In contrast, an "effective amount of the diethylamino ethanol ester of phenaceturic acid" was held "on its face indefinite" because the specification "failed to state the function which is to be rendered effective." *In re Frederiksen*, 213 F.2d 547, 548 (C.C.P.A. 1954).<sup>2</sup>

Here, the specification provides sufficient guidance to allow one of ordinary skill in the art to determine the amount effective to provide transfer-resistant properties.

"Transfer resistance" has a well known meaning in the cosmetics art, as exemplified by the specification. A composition that is not transfer resistant is one that, when applied to the skin, is "at least partly deposited, while leaving a trace, on certain substrates with which [it] can be brought into contact." Specification at p. 2, lines 3-8. For example, a foundation composition with low transfer resistance rubs off easily onto clothing. A

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<sup>2</sup> The specification in *Frederiksen* provided only one specific example. Although the specification limited the upper boundary of added ester, the specification provided "no suggestion that amounts less than that specified ... are desirable or even operable." *Frederiksen*, 213 F.2d at 548.

nontransfer-resistant foundation has "mediocre persistence" and requires frequent reapplication of the foundation composition on the skin. *Id.* at 8-11. The specification also provides exemplary numerical ranges of the ingredients (see, e.g., p. 6, line 17 to p. 7, line 1) and gives exemplary formulations (see, e.g., Examples 1 and 3). Such details fall within the holding of *Marosi* to guide one of ordinary skill in the art to achieve the effective amounts. As in *Halleck*, the Office has put forth no evidence that obtaining a transfer-resistant compound is "beyond" the ordinary skill in the art, in light of the claims and specification, i.e., one of ordinary skill in the art would not have to carry out undue experimentation to achieve a transfer resistant compound. Finally, unlike *Frederiksen*, it is clear that transfer-resistance is the function that is to be rendered effective. Thus, in the present case, one of ordinary skill in the art has a test to ascertain the amounts of emulsion effective to achieve transfer-resistance.

Accordingly, for at least these reasons, Appellants respectfully assert that claim 107 satisfies 35 U.S.C. § 112, second paragraph.

**B. Rejections Under 35 U.S.C. § 103(a)**

**1. There is no motivation to combine Mellul with Nicoll**

The Office maintains the rejection of claims 75-80, 82-86, 90-94, and 97-107 under 35 U.S.C. §103 over Mellul in view of Nicoll. As stated in Section III of this Brief, claim 94 was cancelled in the Amendment After Final filed on August 7, 2002. Thus, only claims 75-80, 82-86, 90-93, and 97-107 are considered here.

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The Office concedes that Mellul does not teach the capability of the wax to confer a penetration force greater than 50 grams on the emulsion as claimed. Final Office Action at p. 3. The Office, however, contends that Mellul discloses polyethylene wax and hydrogenated oils that are solid at 25°C, and that these waxes "preferred" by Appellants would be expected to provide the claimed penetration forces. *Id.* at p. 6. According to the Office, the Appellants can only overcome the rejection by showing "unexpected results over the prior art." *Id.* In the absence of such unexpected results, the Office refuses to give patentable weight to the phrase "capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams." *Id.* at pp. 6-7. Appellants respectfully disagree with the Office's position. *See 539, Col 6 L 62  
for original wax*

In making a rejection under 35 U.S.C. § 103, the Office has the initial burden to establish a *prima facie* case of obviousness. M.P.E.P. § 2143. To establish a *prima facie* case of obviousness, the Examiner must show, among other things, some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. M.P.E.P. 2143.01. Here, the Office has failed to show any such suggestion or motivation.

The present independent claims are each directed to a specific combination of ingredients. Independent claims 75 and 104 each require:

- (1) a solid cosmetic water-in-oil emulsion;
- (2) that the emulsion comprises an aqueous phase emulsified in a fatty phase comprising at least one oil and at least one wax
- (3) that the at least one oil in the fatty phase comprises a silicone oil;

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- (4) that the at least one wax be chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite;
- (5) that the aqueous phase be emulsified using an alkyl dimethicone copolyol corresponding to the indicated formula; and
- (6) that the at least one wax in the fatty phase be capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams.

Claim 107 requires:

- (1) a transfer-resistant cosmetic composition;
- (2) that the cosmetic composition comprises a solid cosmetic water-in-oil emulsion;
- (3) that the emulsion comprises an aqueous phase emulsified in a fatty phase comprising at least one oil and at least one wax;
- (4) that the aqueous phase be emulsified using an alkyl dimethicone copolyol corresponding to the indicated formula;
- (5) that the at least one wax in the fatty phase be capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams; and
- (6) that the solid water-in-oil emulsion be present in the composition in an amount effective to provide transfer-resistant properties to the composition.

Mellul, in contrast, discloses a very large number of compositions without specifically guiding one of ordinary skill in the art to the presently claimed combinations.

First, Mellul teaches that it is possible to obtain emulsions of very different viscosities "ranging from the very fluid to the solid state." Col. 10, lines 16-21. There is no requirement in Mellul that the composition must be a solid. *yes, but 539 teaches solid emulsions with the ingredients @*

Second, Mellul teaches a continuous phase containing at least one fluorohydrocarbon. Col. 2, lines 20-23. The continuous phase can optionally further include various hydrocarbon oils and waxes as additives. Mellul, however, does not

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specifically teach the combination of at least one oil and at least one wax as presently claimed.

Third, Mellul does not require that the at least one oil comprise a silicone oil, and the at least one wax be chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite, as required by claims 75 and 104. Although silicone oils and polyethylene wax are mentioned in Mellul, they are disclosed within a long list of possible oils and waxes.<sup>3</sup> There is no specific teaching for the more narrowly claimed combination.

Thus, one of ordinary skill in the art, faced with a vast number of possibilities, would require hindsight just to arrive at the at least one oil and at least one wax, much less the combination of oil(s) and wax(es) as specifically claimed, e.g., in claims 75 and 104. Hindsight, as the Office is well aware, is an improper basis for a *prima facie* case of obviousness.

Fourth, Mellul teaches the use of two silicone surfactants, each described as a generalized formula. Mellul certainly does not lead one of ordinary skill in the art to the specifically claimed silicone.

Finally, Mellul does not even remotely suggest that its at least one wax must be a wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. The penetration force indicates the structural solidity of the compound.

For instance, Example 3 of the present specification compares two inventive compositions with a non-inventive composition containing carnauba wax. See pp. 20-

<sup>3</sup> The Office alleges that Mellul teaches hydrogenated jojoba oil. Final Office Action at p. 6. Appellants note that Mellul teaches jojoba oil (co. 6, line 42), which is a different compound from hydrogenated jojoba oil, as evidenced by the attached sheets from the International Cosmetic Ingredient Dictionary and Handbook (2000). Jojoba oil is Simmondsia Chinensis seed oil expressed or extracted from seeds of the

21. The comparison illustrates that the non-inventive composition containing carnauba wax, a wax not capable of conferring the claimed penetration force, did not produce a sufficiently solid composition. *See p. 21.*

In summary, the claimed combination of ingredients is directed to a much smaller subset of compositions compared to that disclosed by Mellul. Because Mellul provides no specific teaching or suggestion to guide one of ordinary skill to select these ingredients, the Office has failed to meet the rigorous standard for a *prima facie* case of obviousness.

To remedy these multiple deficiencies of Mellul, the Office relies on Nicoll. Nicoll, drawn to water-in-silicone oil emulsions, does not describe the claimed combination of ingredients for many of the same reasons discussed above for Mellul. In addition, Nicoll directly teaches away from a solid composition because Nicoll teaches that its emulsion is to be formulated as a lotion, a fluid cream, or a cream. See col. 10, lines 32-45; see also Examples 1-4 describing lotions and creams.

Thus, the Office has not established a *prima facie* case of obviousness here. The combination of Mellul and Nicoll does not meet the high standard articulated by the Federal Circuit in *Dembiczak, supra*, and other recent cases, *i.e.*, that the evidence of a motivation to combine must be “clear and particular.” *In re Dembiczkak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Instead, the two references present a myriad of possibilities with no guidance other than hindsight to choose the ingredients to satisfy the requirements of the present claims. Because a *prima facie* case has not been established, Appellants do not have the burden of showing any unexpected results. Only if the Office

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desert shrub, Jojoba, *Simmondsia chinensis*. Hydrogenated jojoba oil is the end product of the controlled

demonstrates a *prima facie* case of obviousness does the burden shift to the Appellants to come forward with evidence persuasive of the invention's nonobviousness. *See In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984).

Regarding claim 107, the Office has refused to give patentable weight to the term "transfer-resistant" alleging that the term states a "preamble use" or is based on a "discovery of a new property." Final Office Action at p. 4. As discussed in the After Final Amendment filed on August 7, 2002, whether a preamble limitation is given weight is based on whether the preamble "gives life, meaning, and vitality" to the claims.

M.P.E.P. § 2111.02, quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). Here, the limitation "transfer-resistant" excludes those compositions that, when applied to the skin, are "at least partly deposited, while leaving a trace, on certain substrates with which they can be brought into contact." See specification at p. 2, lines 3-8. It is clear that a "transfer-resistant" composition is one that has a better than "mediocre persistence" on the skin and does not require "regular renewal" or re-application. *Id.* at lines 9-11. When one considers that claims should be read in light of the specification, this definition in the specification provides the term "transfer resistant" in the claim with life and meaning. *See Markman v. Westview Instruments*, 52 F.3d 967, 979-980 (Fed. Cir. 1995). ("Claims must be read in view of the specification, of which they are a part."). Accordingly, the Office should consider this limitation in its determination of patentability.

Therefore, for at least these reasons, it is respectfully asserted that a *prima facie* case of obviousness has not been established over Mellul in view of Nicoll.

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hydrogenation of jojoba oil.

**2. There is no motivation to combine Mellul with Nojima**

The Office maintains the rejection of claims 75-80, 82-84, 90-94, and 96-107 under 35 U.S.C. §103 over Mellul in view of Nojima. As stated in Section III of this Brief, claim 94 has been cancelled. Thus, only claims 75-80, 82-84, 90-93, and 96-107 are considered here.

Mellul is discussed above. The Office relies on Nojima for teaching "oil-based solid cosmetic compositions comprising a polyoxyalkylated silicone surfactant" and for disclosing polyethylene wax and hydrogenated jojoba oil. Non-Final Office Action at pp. 6-7. The Office further notes that it is "within the skill in the art to select optimal components in a composition in order to achieve a beneficial effect." *Id.* at p. 7.

As discussed above, Mellul fails to teach the claimed combination of ingredients. Nojima does not remedy this deficiency, and if anything, teaches away from Mellul. Nojima states that its oil-based cosmetic compositions are preferably "substantially free from water." Col. 3, lines 40-42. All of the numerous examples are free of added water. Thus, Nojima fails to describe a water-in-oil emulsion. When read as a whole, therefore, the teachings of Nojima teach away from the water-in-oil compositions of Mellul. There can be no motivation to combine references with these divergent teachings.

Appellants note that the Office has continually failed to address, in either the subsequent Final Office Action or the Advisory Action, the substance of Appellants' arguments made in the Amendment filed February 19, 2002. Appellants have argued repeatedly of record that Mellul and Nojima teach away from each other. Mellul is directed to water-in-oil emulsions and provides numerous examples where water is the

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predominant component of the composition. Nojima, in contrast, relates to oil-based cosmetic compositions and provides numerous examples of compositions free of added water. The Office is required to respond to the substance of the Appellants' arguments, yet has not directly addressed the issue that the references teach away from each other. "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." M.P.E.P. § 707.07(f).

Finally, one of ordinary skill in the art cannot simply "select optimal components in a composition in order to achieve a beneficial effect" as claimed. The art provides an infinite number of possible compositions that would not fall within the present claims. Such statements by the Office reflect a rationale that the references can be combined, which is not the standard for *prima facie* obviousness. M.P.E.P. § 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.") (emphasis in original). There must be a teaching or suggestion of the claimed combination of ingredients, including at least one wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams.

Therefore, for at least these reasons, it is respectfully asserted that a *prima facie* case of obviousness has not been established over Mellul in view of Nojima.

### **3. There is no motivation to combine Mellul with Nara**

The Office maintains the rejection of claims 75-80, 82-84, 87-94, and 97-107 under 35 U.S.C. §103 over Mellul in view of Nara. As stated in Section III of this Brief,

claim 94 has been cancelled. Thus, only claims 75-80, 82-84, 87-93, and 97-107 are considered here.

The Office relies on Nara for teaching volatile isoparaffins, as selection of an optimal isoparaffin "is not considered critical." Non-Final Office Action at pp. 7-8.

Appellants submit that the combination of Mellul and Nara is improper. Mellul is discussed above. Nara teaches makeup compositions comprising ethyl hydroxyethyl cellulose and an aromatic hydrocarbon resin having a softening point of at least about 120°C. In contrast, Mellul teaches compositions comprising an aqueous phase emulsified with a silicone surfactant in a continuous phase of a fluorohydrocarbon. There is no teaching in Mellul that the ethyl hydroxyethyl cellulose compositions of Nara would benefit Mellul's compositions. Without a suggestion to combine the Nara compositions with those of Mellul, a *prima facie* case is not established.

Therefore, for at least these reasons, it is respectfully asserted that a *prima facie* case of obviousness has not been established over Mellul in view of Nara.

**4. None of the combinations of references cited by the Office teach each and every claim limitation.**

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." M.P.E.P. § 2143.03.

Even if the combinations of references cited by the Office were proper in the rejections under 35 U.S.C. § 103, each combination fails to teach all of the claim limitations. Mellul fails to teach the claimed combination of ingredients, as discussed above. Moreover, Mellul does not teach the desirability of using at least one wax

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capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams.

The references relied on in combination with Mellul do not remedy these deficiencies. Nicoll, Nojima, and Nara all fail to teach at least one wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams.

Further, although Nara discloses a list of liquid oil ingredients at col. 4, lines 13-18, Nara in no way teaches or suggests selecting at least one oil comprising a silicone oil from this list.

Nojima discloses a large number of polyoxyalkylene modified organopolysiloxanes in col. 2. Nojima, however, does not provide guidance to specifically select the presently claimed alkyl dimethicone copolyol. Further, because Nojima is directed to oil-based cosmetic compositions that are preferably "substantially free from water," Nojima does not teach the use of emulsions. Thus, Nojima cannot possibly teach a solid water-in-oil emulsion present in the composition in an amount effective to provide transfer-resistant properties to the composition.

Therefore, for at least these reasons, it is respectfully asserted that a *prima facie* case of obviousness has not been established.

## IX. Conclusion

For the reasons set forth above, Appellants maintain that a *prima facie* case of obviousness has not been established by the Office based on the cited references, taken alone or in combination. Thus, Appellants respectfully request reversal of all the rejections of claims 75-80, 82-93, and 96-107 under 35 U.S.C. § 103(a), as well as the rejection of claim 107 under 35 U.S.C. § 112, second paragraph.

To the extent any further extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Date: February 28, 2003

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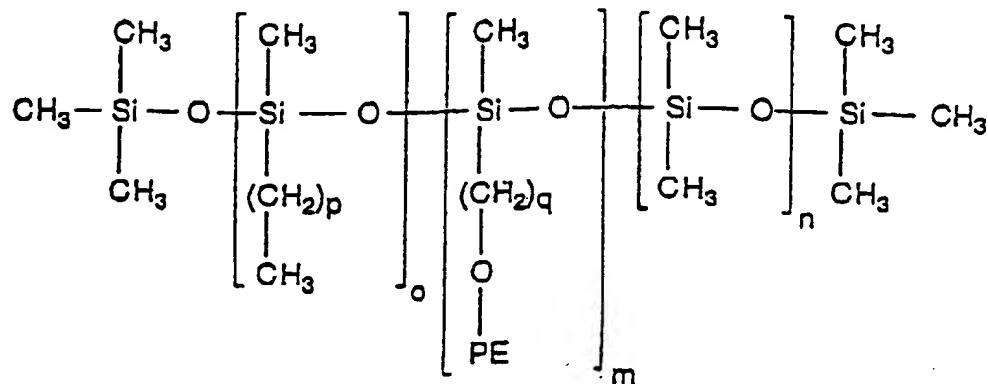
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**APPENDIX - PENDING CLAIMS**

75. A solid cosmetic water-in-oil emulsion comprising an aqueous phase emulsified in a fatty phase comprising at least one oil and at least one wax, wherein the aqueous phase is emulsified using an alkyl dimethicone copolyol corresponding to the following formula:



in which:

PE is  $(-C_2H_4O)_x(-C_3H_6O)_y-H$ ,

x ranges from 0 to 50,

y ranges from 0 to 30, with the proviso that x and y are not simultaneously 0,

o ranges from 1 to 100,

m ranges from 1 to 40,

n ranges from 1 to 200,

p ranges from 1 to 17, and

q ranges from 1 to 5, and

further wherein the at least one wax in the fatty phase is capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams;

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further wherein the at least one oil in the fatty phase comprises a silicone oil, and the at least one wax is chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite. *see (639) Col 6, L 62*

76. The emulsion according to claim 75, wherein  
o ranges from 1 to 25,  
m ranges from 1 to 10, and  
n ranges from 1 to 100.

77. The emulsion according to claim 76, wherein  
o is 21,  
m is 4, and  
n is 73.

78. The emulsion according to claim 75, wherein the alkyl dimethicone copolyol is a mixture of cetyl dimethicone copolyol, polyglyceryl-4 isostearate and hexyl laurate.

79. The emulsion according to claim 75, wherein the alkyl dimethicone copolyol is present in said emulsion in an amount of from 0.5 to 40% by weight with respect to the total weight of the emulsion.

80. The emulsion according to claim 79, wherein the alkyl dimethicone copolyol is present in said emulsion in an amount of from 2 to 12% by weight with respect to the total weight of the emulsion.

82. The emulsion according to claim 75, wherein the silicone oil is chosen from volatile cyclic silicones having from 3 to 8 silicon atoms, volatile linear silicones

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having from 2 to 9 silicon atoms, dimethylsiloxane/methylalkylsiloxane cyclocopolymers, polyalkylsiloxanes with trimethylsilyl end groups, and phenylated silicone oils.

83. The emulsion according to claim 82, wherein the silicone oil is a volatile cyclic silicone having from 3 to 8 silicon atoms.

84. The emulsion according to claim 83, wherein the volatile cyclic silicone having from 3 to 8 silicon atoms is chosen from cyclotetradimethylsiloxane, cyclopentadimethylsiloxane, and cyclohexadimethylsiloxane.

85. The emulsion according to claim 82, wherein the silicone oil is a volatile linear silicone having from 2 to 9 silicon atoms.

86. The emulsion according to claim 85, wherein the silicone oil is a volatile linear silicone having from 2 to 9 silicon atoms is chosen from hexamethyldisiloxane, hexylheptamethyltrisiloxane, and octylheptamethyltrisiloxane.

87. The emulsion according to claim 75, wherein the at least one oil in the fatty phase further comprises a volatile isoparaffin.

88. The emulsion according to claim 87, wherein the volatile isoparaffin is a C<sub>8</sub>-C<sub>16</sub> isoparaffin.

89. The emulsion according to claim 88, wherein the C<sub>8</sub>-C<sub>16</sub> isoparaffin is chosen from isododecane, isodecane, and isohexadecane.

90. The emulsion according to claim 75, wherein the fatty phase further comprises at least one additional component chosen from mineral oils, oils of animal origin, vegetable oils, branched C<sub>8</sub>-C<sub>16</sub> esters, synthetic esters and ethers, hydroxylated esters, polyol esters, fatty alcohols, and fluorinated oils.

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91. The emulsion according to claim 75, wherein the fatty phase further comprises at least one additional ingredient chosen from pigments, pearlescent agents, and fillers, and further wherein the at least one additional ingredient is selected so as not to affect any transfer-resistant properties of said emulsion.

92. The emulsion according to claim 75, wherein the at least one oil is present in said emulsion in an amount of from 10 to 40% by weight with respect to the total weight of the emulsion.

93. The emulsion according to claim 92, wherein the at least one oil is present in said emulsion in an amount of from 18 to 30% by weight with respect to the total weight of the emulsion.

96. The emulsion according to claim 75, wherein the at least one wax is a mixture of polyethylene wax and of hydrogenated jojoba oil.

97. The emulsion according to claim 75, wherein the at least one wax is present in said emulsion in an amount of from 3 to 15% by weight with respect to the total weight of the emulsion.

98. The emulsion according to claim 97, wherein the at least one wax is present in said emulsion in an amount of from 3 to 10% by weight with respect to the total weight of the emulsion.

99. The emulsion according to claim 75, wherein the aqueous phase is present in said emulsion in an amount of from 0.5 to 60% of the total weight of the emulsion.

100. The emulsion according to claim 75, wherein the aqueous phase comprises

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- a) water or a floral water;
- b) 0 to 14% by weight, with respect to the total weight of the aqueous phase, of lower C<sub>2</sub>-C<sub>6</sub> monoalcohols and/or of polyols; and
- c) 0 to 6% by weight, with respect to the total weight of the emulsion, of a thickening agent.

101. The emulsion according to claim 100, wherein the aqueous phase further comprises agents for stabilization of the emulsion.

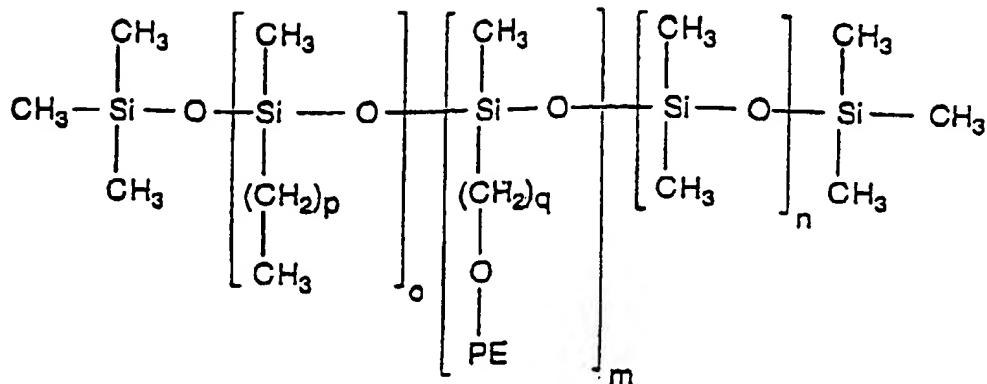
102. The emulsion according to claim 75, wherein it additionally comprises at least one additive chosen from antioxidants, colorants, fragrances, essential oils, preservatives, cosmetic active principles, moisturizers, vitamins, sphingolipids, sunscreen agents, and fat-soluble polymers.

103. The emulsion according to claim 75, wherein the emulsion is a solid, transfer-free compact foundation.

104. A process for making up the skin and/or scalp, comprising applying to the skin and/or the scalp, a solid cosmetic water-in-oil emulsion comprising an aqueous phase emulsified in a fatty phase comprising at least one oil and at least one wax, wherein the aqueous phase is emulsified using an alkyl dimethicone copolyol corresponding to the following formula:

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in which:

PE is (-C<sub>2</sub>H<sub>4</sub>O)<sub>x</sub>(-C<sub>3</sub>H<sub>6</sub>O)<sub>y</sub>-H,

x ranges from 0 to 50,

y ranges from 0 to 30, with the proviso that x and y are not simultaneously 0,

o ranges from 1 to 100,

m ranges from 1 to 40,

n ranges from 1 to 200,

p ranges from 1 to 17, and

q ranges from 1 to 5, and

further wherein the at least one wax in the fatty phase is capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams;

further wherein the at least one oil in the fatty phase comprises a silicone oil, and the at least one wax is chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite.

105. The process according to claim 104, wherein

o ranges from 1 to 25,

m ranges from 1 to 10, and

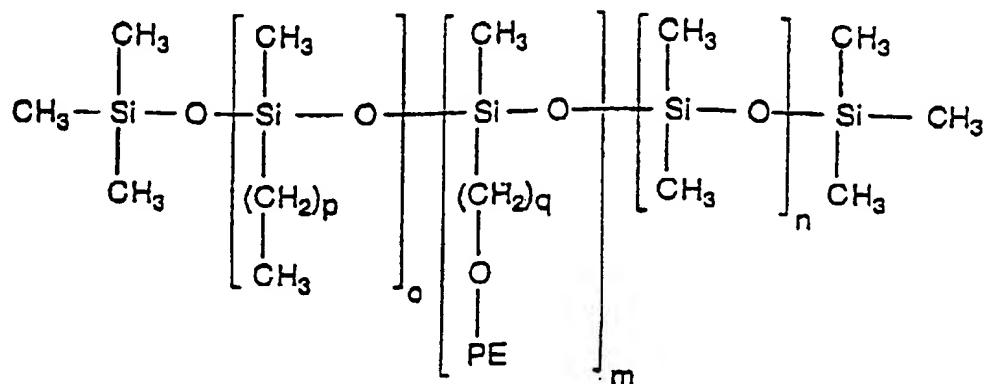
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n ranges from 1 to 100.

106. The process according to claim 105, wherein  
o is 21,  
m is 4, and  
n is 73.

107. A transfer-resistant cosmetic composition comprising a solid cosmetic water-in-oil emulsion comprising an aqueous phase emulsified in a fatty phase comprising at least one oil and at least one wax, wherein the aqueous phase is emulsified using an alkyl dimethicone copolyol corresponding to the following formula:



in which:

PE is  $(-\text{C}_2\text{H}_4\text{O})_x(-\text{C}_3\text{H}_6\text{O})_y-\text{H}$ ,

x ranges from 0 to 50,

y ranges from 0 to 30, with the proviso that x and y are not simultaneously 0,

o ranges from 1 to 100,

m ranges from 1 to 40,

n ranges from 1 to 200,

p ranges from 1 to 17, and

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q ranges from 1 to 5, and

further wherein the at least one wax in the fatty phase is capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams;

and wherein the solid water-in-oil emulsion is present in the composition in an amount effective to provide transfer-resistant properties to the composition.

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